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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,360	01/26/2001	Peng C. Tang	038602/1081	4781

7590

04/07/2004

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,360	Applicant(s) TANG ET AL.	
	Examiner Brenda Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,11,12,15,17,20,21,25-28,31,33,34 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15,17,20,21,25,28 and 31 is/are allowed.
- 6) ☒ Claim(s) 1,26,27,33,34 and 37-39 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 11, 12, 15, 17, 20, 21, 25-28, 31, 33, 34 and 37-39 are pending in the application.

This action is in response to applicant's amendment filed December 23, 2003. Claim 23 has been canceled and claims 1, 11, 12, 15, 17, 20, 25-27, 31, 33 and 34 have been amended.

Response to Amendment

Applicant's arguments filed December 23, 2003 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 1, 11, 12, 15, 17, 20, 21, 23 and 25 labeled paragraph 1 maintained in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 17, 20, 21, 23 and 25 labeled paragraph 3 maintained in the last office action, which is hereby **withdrawn**.
3. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejection of claims 15 and 20 labeled paragraph 6n) maintained in the last office action, which is hereby **withdrawn**.
4. The applicant's amendments are sufficient to overcome the 35 USC § 102, anticipation rejection of claims 31 and 33 labeled paragraph 7 maintained in the last office action, which is hereby **withdrawn**.

5. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejections labeled 9a), d), e) and f) in the last office action, which are hereby **withdrawn**. However, with regards to the 35 USC § 112, first paragraph rejections labeled 9b) and c) in the last office action, the applicants' arguments have been fully considered but are not found persuasive.

b) The applicants' stated that $-OX_7$, with X_7 is hydrogen, saturated or unsaturated alkyl or a five-membered or six-membered aryl or heteroaryl ring moiety, is described on page 23, lines 10-13 of the specification, in the context of the genera of formulae I and III. The amendment to the definition of R_3 , R_4 , R_5 , R_6 , R_7 , R_8 and R_9 is not described in the specification within the genus. The applicants indicated in their remarks that the insertion is supported by the definition of R_3 , R_4 , R_5 , R_6 , R_7 , R_8 and R_9 on page 23, lines 10-13. However, the definition of R_3 , R_4 , R_5 , R_6 , R_7 , R_8 and R_9 on page 23 is part of a sub-generic Formula, i.e. a preferred embodiment under the genus, with specific variables, not the description of the genus of Formula I. Additionally, recent case law *Tronzo v. Biomet* 47 USPQ2d 1829 states that a species in a prior application does not provide written description to a generic claim.

c) The applicants' stated that Z' , where the ring is optionally substituted with one, two or three alkyl, halogen, trihalomethyl, carboxylate, and ester moieties, is in fact, described on page 23, line 23 to page 24, line 1 of the specification, in the context of the genera of formula III. The amendment to the definition of Z' is not described in the specification within the genus. The applicants indicated in their

remarks that the insertion is supported by the definition of the substituents of the ring of Z' on page 23, line 23 to page 24, line 1. However, the definition of the substituents on the ring of Z' on pages 23-24 is part of a sub-generic Formula, i.e. a preferred embodiment under the genus, with specific variables, not the description of the genus of Formula III. Additionally, recent case law *Tronzo v. Biomet* 47 USPQ2d 1829 states that a species in a prior application does not provide written description to a generic claim.

Claims 1, 33, 34 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record and stated above.

6. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejections of claims 1, 11, 17, 20, 21, 23, 25-27, 33, 34 and 37 labeled paragraph 10 of the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 23, 2003, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 26, 27, 34 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 26, 27, 34 and claims dependent thereon are vague and indefinite in that it is not known what is meant by R_{10} in the proviso which follows the definition where R_3 , R_4 , R_5 , R_6 , R_7 , R_8 and R_9 are independently selected from the group consisting of (a) hydrogen.

Claim Objections

8. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

9. Claims 15, 17, 20, 21, 25, 28 and 31 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1624

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Brenda Coleman". The signature is written in black ink and includes a stylized flourish at the end of the name.

Brenda Coleman
Primary Examiner Art Unit 1624
April 5, 2004